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NILANONT, YOUAPORN				
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/526,114

**Applicant(s)**

YABE ET AL.

**Examiner**

YOUAPORN NILANONT

**Art Unit**

2446

**Period for Reply** -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 03 November 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-12 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-12 is/are rejected.
- 7) ☒ Claim(s) 1 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-855)
- Paper No(s)/Mail Date 4/02/2007, 2/28/2005
- 4) ☐ Interview Summary (PTO-413)
- Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

## DETAILED ACTION

### *Specification*

1. The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed.

### *Claim Objections*

2. Claim 1 is objected to because of the following informalities: the first citation of each claimed limitation such as "the user" on line 9 of claim 1 should be changed to --a user-- and "the transmitting apparatus" on line 18 of claim 1 should be changed to --a transmitting apparatus--. Appropriate correction is required.

### *Claim Rejections - 35 USC § 103*

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1, 3-4, 6-7, and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ralston et al. (U.S. Patent No. 6,842,773) in view of Wilson (U.S. Patent Application Publication No. 2004/0015554).

5. **Regarding claim 1**, Ralston reference teaches an email delivery system (Ralston, figure 1 "mail system 112" and column 3 lines 60-61), comprising:

a terminal station accommodated in a first communication network (Ralston, figure 1 "user 116" and column 3 lines 60-62), the terminal station receiving emails transmitted from senders via the first communication network (Ralston, figure 1

"Internet 108" and column 3 lines 54-56, 60-65), obtaining from the senders their identification information, and transmitting the obtained identification information, the identification information identifying a registered sender of an email (Ralston, column 3 lines 40-44);

and a relay apparatus for receiving the identification information, and for storing the received identification information corresponding to an email address of the user of the terminal station (Ralston, figure 2 "approved list 116" and column 4 lines 58-61), the relay apparatus receiving all emails forwarded from senders accommodated in a second communication network to the first communication network (Ralston, figure 1 "mail system 112" and column 3 lines 45-48), and forwarding only those emails whose identification information is stored corresponding to designated email addresses (Ralston, column 4 lines 55-56, 63-65),

wherein the relay apparatus stores the identification information received from the terminal station corresponding to an email address of a user of the terminal station (Ralston, column 4 lines 49-61),

Ralston reference does not explicitly teach that the relay apparatus controls the terminal station to register the email address of the user of the terminal station as a recipient email address at the transmitting apparatus of the sender identified with the identification information.

However, Wilson reference discloses an email system that notifies user of an email from an unknown sender and prompts the user for his decision whether to receive that email (Wilson, page 3 [0028] and page 7 [0087]).

It would have been obvious to the person having ordinary skill in the art, at the time the invention was made, to have modified the Ralston email system to prompt for user's response in deciding whether to receive messages from senders not currently on the list, in order to automate the process of entering new sender into a list of allowed or blocked senders without extra effort from the user and therefore register that the user's email is the recipient of that sender.

6. **Regarding claim 3**, Ralston and Wilson references teach the email delivery system according to claim 1, wherein Ralston and Wilson further teaches the identification information of a sender is a prescribed number of characters of the beginning of the email address of the sender of the email (Ralston, column 6 lines 5-7 and column 20 lines 38-31, Wilson, page 7 [0082] 'postmaster' or 'route').
7. **Regarding claim 4**, Ralston and Wilson references teach the email delivery system according to claim 1, wherein Ralston further teaches the identification information of a sender is configured as a prescribed number of characters of the end of the email address of the sender of the email (Ralston, column 5 lines 4-5 "domains").
8. **Regarding claim 6**, Ralston and Wilson references teach the email delivery system according to claim 1, wherein Ralston reference further teaches the relay apparatus controls the terminal station to provide a user interface (Ralston column 3 lines 51-54) for transmitting the identification information to the relay apparatus, the identification information being transmitted from the sender of the email to the terminal station, and the relay apparatus receives the identification information transmitted according to the user interface (Ralston column 3 lines 54-56).

9. **Regarding claim 7**, Ralston and Wilson references teach the email delivery system according to claim 6, wherein Wilson further teaches the relay apparatus transmits to the terminal station a file, written in a prescribed language, describing procedures of forwarding identification information to the relay apparatus itself, the identification information being transmitted from the sender of the email to the terminal station, and causes the terminal station to display screen in accordance with the details of the file, so that the relay apparatus controls the terminal station to provide a user interface for transmitting the identification information to the relay apparatus, the identification information being transmitted from the sender of the email (Wilson, page 7 [0087] "pop-up window...prompt user to decide...").

10. **Regarding claim 12**, Ralston teaches a relay apparatus (see figure 2 "112"), comprising:

receiving means for receiving from a terminal station identification information, the terminal station being accommodated in a first communication network (Ralston, figure 2 "user 116"), receiving emails transmitted from senders (Ralston, figure 2, "unsolicited mailer 104") via the first communication network (Ralston, figure 2 "Internet"), obtaining from senders their identification information, the identification information identifying a sender of an email which a user of the terminal station wishes to receive (Ralston, column 3 lines 40-44);

and storing means for storing the identification information received by the receiving means corresponding to an email address of the user of the terminal station (Ralston, figure 2 "approved list 216");

forwarding means for forwarding to each recipient each email from among all the received emails (Ralston, figure 2 "mail transfer agent(s) 204"), wherein the identification information of the sender of each email is stored corresponding to a designated email address (Ralston, column 4 lines 55-56, 63-65).

Ralston does not explicitly disclose control means for controlling the terminal station to register the email address of the user as a recipient email address at the transmitting apparatus of the sender identified with the identification information.

However, Wilson teaches an email system with active filter that provides a way to control the user's terminal to display a pop-up window to prompt for user's decision whether to receive an email from a particular sender or not (Wilson, page 7 [0087]).

It would have been obvious to the person having ordinary skill in the art, at the time the invention was made, to have modified the Ralston email system to prompt for user's response in deciding whether to receive messages from senders not currently on the list, in order to automate the process of entering new sender into a list of allowed or blocked senders without extra effort from the user and therefore register that the user's email is the recipient of that sender.

11. Claims 2, 5, and 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ralston et al. (U.S. Patent No. 6842773) in view of Wilson (U.S. Patent Application Publication No. 2004/0015554) as applied to claim 1 above, and further in view of common knowledge in the art

12. **Regarding claim 2**, Ralston and Wilson references teach the email delivery system according to claim 1.

Ralston and Wilson do not explicitly disclose that the identification information of a sender is assigned in the second communication network to identify a sender of an email. However, it was commonly known in the art that the sender's email address as specified and used as sender's identification in both Ralston and Wilson references are assigned in the sender's own network and not in the receiver's network.

Therefore, it would have been obvious to the person having ordinary skill in the art, at the time the invention was made to have assumed that the sender's email address was assigned to the sender by the sender's network in order to conform to the existing email system without additional effort.

13. **Regarding claim 5**, Ralston and Wilson references teach the email delivery system according to claim 1, wherein

the terminal station obtains identification information of one or a plurality of senders, the identification information identifying a sender of an email (Ralston, column 3 lines 40-44),

the terminal station transmits the identification information selected by the user to the relay apparatus (Ralston, column 3 lines 40-44).

Ralston and Wilson do not explicitly specify that the terminal station prompts a user of the terminal station to select one of the users for whom identification information is obtained. However, it was commonly known in the art at the time of the invention that any mail system such as used in Ralston reference (Ralston column 3 lines 45-59)



requires a login by the user of such terminal before he can access his emails.

Therefore, it would have been obvious to the person of ordinary skill in the art, at the time the invention was made, to have included a user login page prompted by the terminal in Ralston email system for the security and privacy purposes.

14. **Regarding claim 10**, Ralston and Wilson references teach the email delivery system according to claim 1.

Ralston and Wilson do not explicitly state wherein on receiving the identification information transmitted from a terminal station, the relay apparatus determines whether to allow the user of the terminal station to make use of the relay apparatus itself, only in the case of allowing the user, the relay apparatus obtains an email address of the user, and stores the obtained email address corresponding to the identification information transmitted from the terminal station.

However, it was commonly known in the art at the time of the invention that any mail system such as used in Ralston reference (Ralston column 3 lines 45-67) requires a login by the user of such terminal before he can access his emails. Therefore, it would have been obvious to the person of ordinary skill in the art, at the time the invention was made, to have included a user login page prompted by the terminal in Ralston email system for the security and privacy purposes.

15. Claims 8 and 9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ralston et al. (U.S. Patent No. 6842773) and Wilson (U.S. Patent Application Publication No. 2004/0015554) as applied to claim 7 above, and further in view of Mathur et al. (U.S. Patent No. 6581072).

16. **Regarding claim 8**, Ralston and Wilson references teach the email delivery system according to claim 7, wherein the terminal station transmits the identification information of a sender to the relay apparatus, the identification information identifying a sender of the email (please see rejection regarding claims 1 and 6 above).

Ralston and Wilson do not disclose that the terminal station deletes the file transmitted from the relay apparatus. However, Mathur reference discloses a system that allows the user to delete web page cookies in order for user to preserve privacy (Mathur, column 15 lines 10-13, 15-16). It would have been obvious to the person having ordinary skill in the art, at the time the invention was made, to have used Mathur technique of deleting cookies or transmitted files in Ralston's and Wilson's terminal station in order to protect privacy of the user of the terminal station (Mathur, column 15 lines 15-16).

17. **Regarding claim 9**, Ralston and Wilson references teach the email delivery system according to claim 7. Ralston and Wilson do not teach wherein the relay apparatus prohibits the terminal station from storing a locator of the file.

However, Mathur reference discloses a system that provides filter that allows automatic deletion of web page cookies in order for user to preserve privacy (Mathur, column 15, lines 13-20). It would have been obvious to the person having ordinary skill in the art, at the time the invention was made, to have used Mathur technique of deleting cookies or transmitted files in Ralston's and Wilson's terminal station in order to protect privacy of the user of the terminal station (Mathur, column 15 lines 15-16).

18. **Regarding claim 11**, Ralston and Wilson references teach the email delivery system according to claim 1 (Ralston, figure 1 "mail system 112" and column 3 lines 60-61), wherein

the terminal station obtains from a sender of an email identification information, the identification information identifying a sender of an email the terminal station transmits to the relay apparatus the obtained identification information (Ralston, column 3 lines 40-44), the relay apparatus receives the identification information (Ralston, column 4 lines 49-61).

Ralston and Wilson do not teach the system wherein the terminal station transmits to the relay apparatus time information indicating a time of obtaining the identification information, the relay apparatus receives the time information transmitted from the terminal station, only in the case that difference between the time indicated by the received time information and the time of receiving the time information are shorter than a prescribed time, the relay apparatus stores the received identification information corresponding to the email address of the user of the terminal station.

However, the Adkins reference teaches an email system with unwanted email filter that allows the user to filter the temporary list to include only identification of sender of message sent within a specified time wherein the user is able to add a sender's identification in that temporary list to the inclusive list (page 4 [0065]-[0067]).

It would have been obvious to the person of ordinary skill in the art, at the time the invention was made, to have included such timing feature as taught by Adkins into

modified Ralston's email system, in order to automatically limit the number of sender's identification to be added to the user's inclusive list.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to YOUPAPORN NILANONT whose telephone number is (571) 270-5655. The examiner can normally be reached on Monday through Thursday and alternate Friday at 7:30 AM - 5 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jeffrey C. Pwu can be reached on (571) 272-6798. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Y. N./  
12/22/2008  
Examiner, Art Unit 2446

/Jeffrey Pwu/

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Supervisory Patent Examiner, Art Unit 2446